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10/631,089	07/30/2003	Paige Fortner	FORP121050	2026
26389 7590 05/16/2008 CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347				
EXAMINER				
HALE, GLORIA M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/631,089

Applicant(s)

FORTNER, PAIGE

Examiner

Gloria Hale

Art Unit

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 2-19-08 Amendment/RCE.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,7-12,27-29 and 32-36 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,3,7-12,27-29 and 32-36 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 1,3,7-12,27-29 and 32-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 5; claim 7, line 5; claim 8, line 5; claim 9, line 5; claim 11, line 5; claim 12, line 5; claim 27, line 4; claim 32, line 4; claim 33, line 4; claim 34, line 4; and claim 35, line 4, the recitation "to correspond to a breast region or shoulder region of a user" is not clear. A dome-shaped construction means that an outer surface is dome shaped and it is not clear as to how the dome shape corresponds to a breast region or a shoulder region. Does the dome shape emulate the shoulder or breast that is adjacent to the one that it is emulating or is the dome-shaped body hollow so that it conforms to the protruding shoulder or breast region. Also, shoulders and breasts are of a different shape and it is not clear as to how a single structure could conform to either a breast or a shoulder or if applicant is claiming two different embodiments in one claim wherein one dome shaped pad is made to conform to a breast and another is made to conform to a shoulder. Therefore, the structures are not structurally equivalent and cannot be claimed in the alternative in a single claim. IT is also not clear as to what structure the recitation "to correspond to a breast region" or "to correspond to a shoulder region" encompasses All that is claimed is an outer dome shaped surface but it is not clear if the dome shape is solid or hollow inside or on an inner surface. The independent claims then go on to claim the dome shaped configuration as a partial dome shape

so it is not clear as to what the metes and bounds of the dome shape is. Claim 9 is not clear in that the preamble claims a garment pad and the dependent claims claim a garment pad kit. In claim 11, line 7 is not clear in that it is not clear if applicant is claiming double sided tape twice or once since it is claimed twice and is not clear. Claim 12 is unclear in lines 6-9 as in claim 11. The last line of claim 12 "an arcuate a partial dome" is not clear. In claim 27 it is not clear if the support layer is already in a dome shape and is attached to the body of the pad or if it is a separate layer since the recitation "for assisting" is somewhat of a a method step. Claims 32 -35 are not clear for the same reasons in regard to "for assisting". Claim 36 is not clear in that the bra pad and the shoulder pad are not structurally equivalent structures.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,27,28 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Sneider (US 4,674,510).

Sneider discloses a garment pad kit with a garment pad that is three dimensionally dome shaped and an adhesive to couple the outer adhering surface to the garment. The recitation "adapted to couple the bonding fabric to a garment when the bonding fabric is disposed between the garment pad and the user" is intended use and the Sneider pad

Art Unit: 3765

is placed with the adhesive adjacent to the garment as claimed. Sneider provides the pad 14 with the adhesive 18 as broadly claimed in claim 1 as seen in figures 1 and 4A and col. 3, line 44- col. 4, line 20). IN regard to claim 27, SNeider discloses the reusable body 64 with a inner surface 10 and an outer surface 14 with an adhering surface with the body being three dimensionally dome shaped to correspond to a breast region and an adhesive 18 disposed on the outer adhering surface as claimed. (See Sneider, c ol. 3, line 44 – col. 4, line 20 and figures 1-4A). The adhesive is pressure sensitive and is a bra pad as claimed in claim 36.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sneider in view of Kenyon (US 5,569,345)

Sneider discloses the garment pad substantially as claimed except for the temperature sensitive adhesive. Kenyon discloses the use of a temperature and pressure sensitive adhesive that is a functional upon heating and ironing the adhesive with pressure.

Accordingly it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the pad kit of Sneider to include a temperature adhesive as disclosed by Kenyon to provide a better adhesion of the pad onto the garment for a permanent attachment. Such adhesives are well known and the mere

Art Unit: 3765

substitution of one type of adhesive for another would have been an obvious modification to one of ordinary skill in the art. The Kenyon temperature sensitive iron on adhesive includes a bonding fabric as claimed. The bonding layer of Kenyon is the support layer as broadly claimed. (See Kenyon, col. 3, lines 15-34).

Claim 10 is rejected under 35 USC 103a as being unpatentable over Sneider in view of well known double sided tape.

Sneider discloses the pad with the pressure sensitive adhesive. However, Sneider does not include the use of a double sided tape to presently attach the pad to the garment. It is well known to attach garment appliques and pads onto garments with double sided tape such as a double sided clear tape used in gift wrapping or garment seam tape. IT would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Sneider pad to use well known double sided tape in place of or in addition to the pressure sensitive adhesive to permanently adhere the pad onto the garment since such adhesion of items onto a garment with a permanent liquid adhesive is also well known.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

Art Unit: 3765

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,3,7-12,27-29 and 32-36 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 10-27 of copending Application No. 10/845016. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim the same pad structures with the bonding fabric or sheet with the relief cuts, gaps or apertures that is adhesively attached to the pad and then attachés the pad to the garment..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Upon further consideration of the present claims and applicants co-pending application the new rejections under 112 and SNeider are now re-included in the present Office Action because of the lack of clarity I regard to the shoulder pad or breast pad construction. The allowable subject matter of the relief cuts, apertures and gaps and the double sided tape with the arcuate shape remains. Therefore, claims 7,8,9,10,11,12

and 32-35 are objected to. The Sneider pad discloses the claimed structure as claimed and as discussed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria Hale whose telephone number is 571-272-4984. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on 571-272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gloria Hale/
Primary Examiner, Art Unit 3765
